

App. No. 10/613,226

Amendment under 37 CFR §1.111

**REMARKS**

Claims 1-22 remain pending and under consideration. Claims 1, 6, 7, 9, and 16 are independent claims. Claims 1, 3, 6, 7, 9, and 16 have been amended. Reexamination and reconsideration of the application, as amended, are hereby respectfully requested.

***Allowable Subject Matter***

Examiner has objected to Claims 4, 6, 7, 9, and 18 as being dependent on a rejected base claim, but allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Claims 6, 7, and 9 have been rewritten in independent form and include all of the limitations of base Claim 1 and intervening Claim 5 (for Claims 6 and 7) or intervening Claim 8 (for Claim 9). Claims 4 and 18 have not been amended; however, respective base Claims 1 and 16 have been amended and are believed allowable, as set forth hereinbelow.

***Rejections under 35 USC §103***

Examiner has rejected Claims 1-3, 5, 8, 10-17, and 19-22 under 35 USC §103 as being unpatentable over Kato et al (US5737467) in view of Bradley (US5123070).

The rejections are believed overcome since it is believed that Claims 1-5, 8, and 10-22, as amended, patentably distinguish over Kato et al and Bradley.

Regarding independent Claims 1 and 16, each has been amended to include the following limitations: i) "the micro-hermetic cavity completely circumscribes the interior volume"; and ii) "a portion of the transmission optical waveguide integrally forms a portion of a wall of the micro-hermetic cavity at a position where the waveguide passes through the wall". These limitations are clearly disclosed, e.g., in the original drawings.

Neither of these limitations is disclosed, taught, or suggested by Kato et al or by Bradley. Since not all limitations recited in Claims 1 or 16 are disclosed therein, the references of Kato et al and Bradley do not support a *prima facie* case of obviousness (MPEP §2143.03). Therefore, rejection under 35 USC §103 is improper, and Applicants respectfully request withdrawal of the same.

Furthermore, modification of the device disclosed by Kato et al to meet the newly added limitations of amended Claims 1 and 16 would render it unsatisfactory for its intended purpose, therefore the reference of Kato et al cannot support, alone or in

Faxed to 571-273-8300 on 08/19/2005

Page 7 of 9

App. No. 10/613,226

Amendment under 37 CFR §1.111

combination with another reference, a *prima facie* case of obviousness (MPEP §2143.01). A slot or opening through a wall of the cavity is required in the device of Kato et al for receiving the fiber ferrule. If walls completely circumscribed the cavity, the fiber ferrule could not be positioned as required by the disclosure of Kato et al.

Regarding Claims 2, 3, and 17, neither Kato et al nor Bradley discloses that the transmission optical waveguide and the micro-hermetic cavity are formed concurrently using a common material processing sequence (Claims 2 and 17), nor does either disclose that the waveguide and cavity are both formed from the same core and cladding materials (Claim 3). Since not all limitations recited in Claims 2, 3, or 17 are disclosed therein, the references of Kato et al and Bradley do not support a *prima facie* case of obviousness (MPEP §2143.03). Therefore, rejection under 35 USC §103 is improper, and Applicants respectfully request withdrawal of the same.

Regarding Claims 11-14 and 21, neither Kato et al nor Bradley discloses that the transmission optical waveguide is adapted for reducing optical loss induced by the presence of the micro-hermetic cavity (Claims 11 and 21), nor does either disclose any specific adaptations for such loss reduction (Claims 12-14). Since not all limitations recited in Claims 11-14 or 21 are disclosed therein, the references of Kato et al and Bradley do not support a *prima facie* case of obviousness (MPEP §2143.03). Therefore, rejection under 35 USC §103 is improper, and Applicants respectfully request withdrawal of the same.

#### ***Other Claim Amendment***

In a case recently decided by the United States Court of Appeals for the Federal Circuit (CAFC), certain language in one of the patents at issue, similar to language originally employed in one of the claims of the instant application, has been construed in a manner differing from that intended by the Applicants. It is not clear whether the CAFC claim construction is specific to the fact patterns of the decided case, or may be applied more generally. Accordingly, the claim in question has been amended so as to ensure that the claims will be construed in the manner originally intended by the Applicants.

The recently-decided case is *Superguide Corporation v. Directv, Inc.* (CAFC 02-1561, -1562, and -1594, decided 02/12/2004). At least within the context of *Superguide*, the Court has interpreted "at least one of" followed by a conjunctive list of

Faxed to 571-273-8300 on 08/19/2005

Page 8 of 9

App. No. 10/613,226

Amendment under 37 CFR §1.111

items in the patent in suit (US 5038211) to mean at least one of *each* item in the list. In the instant application, the Applicants intended "at least one of" followed by such a list to mean at least one item *from* the list. It is presumed that this was the interpretation of the Examiner as well. Since the claim construction of the CAFC in *Superguide* may at least raise the possibility of a narrower claim construction than that intended by the Applicants, Claim 3 has been amended. The phrase "at least one of" has been deleted, and the conjunction "and" in the subsequent pair of items has been replaced by the conjunction "or". In the specification and claims, the conjunction "or" is to be construed inclusively (e.g., "a dog, a cat, or a mouse" would be interpreted as "a dog, or a cat, or a mouse, or any two, or all three"; Bryan A. Garner, Elements of Legal Style p. 103, 2nd ed. 2002), unless: i) it is explicitly stated otherwise, e.g., by use of "either...or", "only one of", or similar language; or ii) two or more of the listed alternatives are mutually exclusive within the context of the claim, in which case "or" would encompass only those combinations involving non-mutually-exclusive alternatives. Applicants believe that this amendment does not change the scope of the amended claim from the originally intended scope. In particular, the amendment set forth herein is not a narrowing amendment.

### **Conclusion**

In view of the above, it is submitted that Claims 1-22 are in condition for allowance. Allowance of Claims 1-22 at an early date is earnestly solicited.

Respectfully submitted,

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Faxed to 571-273-8300 on 08/19/2005

Page 9 of 9